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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/868,216 06/03/97 GIORDANO III

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EXAMINER

NGUYEN, S

ART UNIT

PAPER NUMBER

2731

19

DATE MAILED:

10/03/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

6

## Office Action Summary

Application No. <b>08/868,216</b>	Applicant(s) <b>Giordano III</b>
Examiner <b>Steven Nguyen</b>	Group Art Unit <b>2664</b>

Responsive to communication(s) filed on Sep 19, 2000

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claim

Claim(s) 1-20, 22, and 24-65 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-20, 22, and 24-65 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 17

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

Art Unit: 2664

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to the amendment E filed on 9/19/2000. Claims 21 and 23 have been canceled and claims 1-20, 22 and 24-65 are pending in the application.

### ***Allowable Subject Matter***

2. The indicated allowability of claims 1-20 and 22 are withdrawn in view of the newly discovered reference(s) to Miller. Rejections based on the newly cited reference(s) follow.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

4. Claims 1, 4-5, 10-11, 24, 27-28 and 32-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Miller (USP 5946647).

Regarding claims 1, 4-6, 10-11, 24, 27-28 and 32-34, Miller discloses a method of performing on an electronic document containing text information during communication session

Art Unit: 2664

which comprises the step of parsing (Fig 3, Ref 310 is a parser, Parse information for identifying telephone number, automatically dial the number without the user to enter telephone number), recognized the telephone number (Fig 4) and adding code to form a telephone icon such screen label, a graphic button, highlighted (adding code to create a highlighting for allowing the user to select and dial the telephone number from the computer, See Fig 6) for displaying on the GUI (See col 5, lines 5-50 and col 6, lines 8-25).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-3, 7-9, 12-20, 22, 25-26, 29-31 and 35-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller (USP 5923736) in view of Shachar (USP 5764736).

Regarding claims 2-3, 7-9, 12-20, 22, 25-26, 29-31 and 35-65, Miller discloses a method of performing on an electronic document containing text information during communication session which comprises the step of parsing (Fig 3, Ref 310 is a parser, Parse information for identifying telephone number, automatically dial the number without the user to enter telephone number), recognized the telephone number (Fig 4) and adding code to form a telephone icon such screen label, a graphic button (adding code to create a highlighting for allowing the user to select

Art Unit: 2664

and dial the telephone number from the computer). However, Miller does not disclose Parsing HTML code and transparently disconnecting from Internet session upon selection of the telephone number. In the same field of endeavor, Shachar discloses transparently disconnecting from the session upon the user clicks on the telephone icon to dial the number (Col 6, lines 1-14); reconnecting a data session when a telephone session is terminated (Col 6, 11-14); pattern-recognizer (See Fig 4a, 410); Internet capable telephone for recognizing a telephone number in the telephone tag “telephone icon” (Col 6, lines 24-26, col 5, lines 52-60); after interpreting the text information and adding code, a web browser will display a web page with all the information such as telephone number with graphic associated with it (Col 5, lines 42-47); storing a telephone number in the address book is well known in the art;

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to applying the method of transparently connecting or disconnecting the communication session as disclosed by Shachar into Miller’s communication system. The suggestion/motivation would have been to prevent human error. Furthermore, the method of recognized pattern is well known in the art for recognizing the text telephone number.

### *Conclusion*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Nguyen whose telephone number is (703) 308-8848. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

Art Unit: 2664

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin, can be reached on (703) 305-4366.

The fax phone number for this group is (703) 305-3988.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Steven Nguyen  
Art Unit 2731  
September 29, 2000

  
CHI H. PHAM  
SUPERVISORY PATENT EXAMINER  
GROUP 2700  
10/2/00